

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Non-elected claims 21 and 22 have been canceled without prejudice or disclaimer. New claims 23 and 24 have been added. The heating step specified in claim 23 finds support on page 13, lines 27-28 of the specification. New claim 24 finds support throughout the specification and originally filed claims. Note particularly the Example on page 13 and page 8, lines 1-3 of the specification. Claims 1-20, 23 and 24 are currently pending in this application.

Turning to the Office Action, claims 1-3, 8, 9, 14, 16, 19 and 20 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,876,551 to Jackson in view of U.S. Patent No. 4,902,722 to Melber for the reasons given in paragraph (4) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

The present claims are directed to a process for manufacturing a designed glass fiber fabric wall covering which includes the steps of applying at least the following layers to the glass fabric: initially, a chemical dispersion which typically adds volume and opacity to the fabric; a hydrophobic coating to selected portions of one side of the glass fabric to form a first image layer; a second image coating to selected areas of the fabric, the second image coating containing a polymeric binder and expandable chemicals which upon heating, form a volumetric imaged pattern. The resultant product is a wallcovering which exhibits an imaged pattern and which can be subsequently painted to create three-dimensional designs and patterns. The

combined disclosures of the relied-upon documents do not disclose or suggest the claimed method.

The wall covering described in Jackson '551 is breathable and includes a plastisol coating having a "multiplicity of miniature discontinuities" which provide moisture vapor permeability to the wall covering. Because the plastisol coating provides a smooth outer surface (column 2, lines 15, 23, 41), the surface can be provided with a printed decorative design (column 2, lines 50-57). Thus, the stated objective in Jackson '551 is to provide a wall covering having a smooth, moisture-permeable outer surface which can be printed to provide a pattern "having relatively smooth, sharply defined edges" (column 2, lines 54-55). There is no disclosure or suggestion in this reference of subsequently applying a second image coating containing expandable chemicals.

Melber '722 discloses decorative coating formulations containing expandable microspheres which are designed to be applied to rough surfaces (column 2, line 44) to form three-dimensional graphic effects. The theory of the rejection is that it would have been obvious to apply the expandable formulation of Melber '722 to the breathable wall covering of Jackson '551 to achieve a three-dimensional graphic effect. Respectfully, Applicants disagree.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

motivation to modify the relied on prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. In re Napier, 55 F.2d 610,613; 34 U.S.P.Q.2d 1782,1784 (Fed. Cir. 1995). Obviousness cannot be established by modifying the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the modification. In re Geiger, 815 F.2d 686,688; U.S.P.Q.2d 1276,1278 (Fed. Cir. 1987).

The breathable wall covering disclosed in Jackson '551 already has a design printed on its outer surface. There is no disclosure in either reference which would suggest or motivate one of ordinary skill to apply a second design coating to the printed design already present on the surface of the wall covering. Moreover, the expandable formulation of Melber '722 provides what appears to be a three-dimensional layer of non-uniform thickness. This would be incompatible with the objective of Jackson '551 to provide a smooth-surfaced wall covering.

Applicants also note that the plastisol layer in the Jackson '551 wall covering has minute discontinuities to allow passage of water vapor. Applying the coating layer of Melber '722 to this plastisol layer would likely cover the minute discontinuities and render the wall covering inoperative for the purpose intended by the patentee. Thus, there would have been no reasonable expectation that combining the references' teachings would be successful in providing a breathable wall covering having a smooth outer surface.

For at least the above reasons, the §103(a) rejection based on Jackson '551 in view of Melber '722 should be reconsidered and withdrawn. Such action is earnestly requested.

Claims 1-20 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,291,011 to Edlund in view of U.S. Patent No. 4,902,722 to Melber. The Examiner's rationale is set forth in paragraph (5) of the Office Action.

Edlund '011 is assigned on its face to Johns Manville International, Inc. The present application is assigned to Johns Manville Europe GmbH. According to 35 U.S.C. §103(c), subject matter which qualifies as prior art under 35 U.S.C. §103 via 35 U.S.C. §102(e) may be disqualified as prior art if the subject matter of the reference and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an objection of assignment to the same person."

Applicants unequivocally state that the present application and the Edlund '011 patent were, at the time the present invention was made, owned by or subject to an obligation of assignment to the same person, i.e. the Johns Manville organization. Accordingly, Edlund '011 is disqualified as prior art under 35 U.S.C. §103.

For at least the above reason, the §103(a) rejection based on Edlund '011 in view of Melber '722 should be withdrawn and such action is respectfully requested.

Claims 1-20 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,337,104 to Draxo et al. in view of U.S. Patent No. 4,902,722 to Melber for the reasons advanced in paragraph (6) of the Office Action. Reconsideration and withdrawal of this rejection is requested for at least the following reasons.

The Draxo et al. '104 patent is assigned on its face to Johns Manville Europe GmbH. The present application also is assigned to Johns Manville Europe GmbH. Applicants unequivocally state that the present application and the Draxo et al. '104

patent were, at the time the present invention was made, owned by, or subject to an obligation of assignment to the same person, i.e. Johns Manville Europe GmbH. Accordingly, Draxo et al. '104 is disqualified as prior art under 35 U.S.C. §103.

For at least the above reasons, the §103(a) rejection based on Draxo et al. '104 in view of Melber '722 should be withdrawn. Such action is earnestly requested.

Claims 1-20 were rejected on the ground of obviousness-type double patenting as unpatentable over claims 1-16 of Edlund '011 or as unpatentable over claims 1-23 of Draxo et al. '104, each in view of Melber '722 for the reasons advanced in paragraphs (8) and (9) of the Office Action. Withdrawal of these rejections is requested for at least the following reasons.

Applicants disagree with the Examiner's position and believe that the present claims are directed to an invention which is patentably distinct from that claimed in Edlund '011 or Draxo et al. '104. However, to expedite prosecution of this application, Applicants are submitting herewith a Terminal Disclaimer to obviate these rejections. The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

In view thereof, the obviousness-type double patenting rejections have been obviated and should be withdrawn.

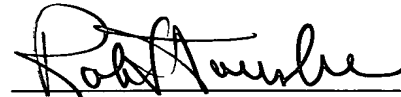
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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